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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,931	09/17/2001	Aaron Lieben	LIEBEN-3X	8229
7590	03/03/2006		EXAMINER	
Jeffrey Hall 212 Clinton Street Santa Cruz, CA 95062			SMITH, TRACI L	
			ART UNIT	PAPER NUMBER
			3629	
DATE MAILED: 03/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/954,931	LIEBEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Traci L. Smith	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 21 December 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 6-12 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

### **DETAILED ACTION**

1. This action is in response to papers filed on December 21, 2005.
2. Claims 6-12 have been elected.
3. Claims 1-5 have been withdrawn
4. Claims 1-12 are pending.
5. Claims 6-12 are rejected.

#### ***Election/Restrictions***

6. Applicant's election without traverse of 6-12 in the reply filed on December 21, 2005 is acknowledged.
7. Claims 1-5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 21, 2005.

#### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-10 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for match score and scoring weight, does not reasonably provide enablement for calculating. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The disclosure teaches

two different ways in which a match score is determined. The disclosure teaches a scoring weight "may" be determined from biodata but it fails to identify how that biodata is used to create or "calculate" a scoring weight. One skilled in the art would not be able to determine which process to use and therefore would not be able to make the invention.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-12 are rejected under 35 U.S.C. 101 because they do not produce a concrete and tangible result. Claim 6 is directed towards selecting a participant to communicate based on a comparison of profiles and answers. There is not a concrete step in comparing the profiles and answers. One user might compare the profiles and answers and determine the participants are not compatible where as a second user might determine they are compatible. Claim 8 is directed calculating a scoring weight that is arbitrarily assigned which is subjective data and does not allow for reproducible results; the results are therefore unpredictable. Claims 9-10 are directed to a match score; again the disclosure teaches two different methods of determining a match score which would also be subjective data and does not allow for reproducible results; the results are therefore unpredictable.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,052,122 Sutcliffe et al; Method and Apparatus for matching Registered Profiles.

13. As to claims 6 and 12 Sutcliffe teaches:

comparing profiles to answers of two different participants(C. 2 l. 44-47). Tracking and tallying responses(C. 9 l. 56-59) user responses to previous contacts. Sutcliffe fails to teach decreasing and increasing tally according to specific response. However, it would have been obvious to one of ordinary skill in the art to decrease for negative response and increase for positive response in

order to prioritize candidates; so that those candidates with the lowest tally would have the lowest priority.

14. As to claim 7 Sutcliffe teaches selecting a participant to communicate with from a list of recommended contacts(C. 2 l. 65-67 and C. 3 l. 1).

15. As to claim 8 Sutcliffe teaches weighting answers to a survey based on users profile(C. 9 l. 49-51).

16. As to claim 9 Sutcliffe teaches calculating a score between two participants(C. 9 l. 56-59).

17. As to claim 10 Sutcliffe teaches calculating a score between a user and multiple participants.(C. 9 l. 59-61).

18. As to claim 11 Sutcliffe teaches storing everything a user is matched or doesn't respond to a contact(negative response). (C. 10 l. 20-25).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TLS



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